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IN THE

# Supreme Court of the United States

OCTOBER TERM, 1943.

897  
No. ....

HENRY I. WARDEN,

*Petitioner,*

*vs.*

CITY OF ST. LOUIS, MISSOURI,

*Respondent.*

**PETITION FOR A WRIT OF CERTIORARI TO THE  
UNITED STATES CIRCUIT COURT OF APPEALS  
FOR THE EIGHTH CIRCUIT AND BRIEF IN SUP-  
PORT THEREOF.**

HAROLD OLSEN,

*Counsel for Petitioner.*



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## **PETITION.**

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*To the Honorable, the Chief Justice, and the Associate Jus-  
tices of the Supreme Court of the United States:*

Your petitioner, Henry I. Warden, respectfully prays that a writ of certiorari issue to the United States Circuit Court of Appeals for the Eighth Circuit to review a decree of that court entered February 14, 1944 (R. 321) affirming a decree of the District Court of the United States for the Eastern District of Missouri (R. 306). A certified transcript of the record in the case, including the proceedings in said Circuit Court of Appeals, together with the necessary additional copies thereof, has been filed in compliance with Rule 38 of the rules of this Court.

### **Summary and Short Statement of the Matter Involved.**

This is a patent infringement suit brought by the petitioner against the City of St. Louis, Missouri, in which the District Court entered a judgment of dismissal on the ground of invalidity of the claim sued upon (R. 306), the judgment being affirmed by the Court of Appeals (R. 321).

The District Court did not file an opinion but, in compliance with Rule 52 of the Federal Rules of Civil Procedure, entered Findings of Fact and Conclusions of Law (R. 303-306). The opinion of the Court of Appeals is at pages 315-321 of the record.

Petitioner is the patentee and owner of United States Letters Patent No. 1,955,569, issued April 17, 1934 (R. 42). A patent being originally refused by the Patent Office, Warden filed an action (R. 265) against the Commissioner pursuant to § 4915 of the Revised Statutes (35 U. S. C. § 63) in the United States District Court for the District of Columbia and there obtained the adjudication of Mr. Justice Bailey that he was entitled to a patent containing the claims which now appear in it (R. 281).

The title of the patent is "Licensing of Motor Vehicles" and it relates to a license tag for motor vehicles in the form of a frangible film, such as a decalcomania, which by reason of its frangibility cannot be removed without destruction or without leaving permanent evidence of its removal. Warden was concerned with the problem of preventing the theft of automobile license tags and their unauthorized transfer from one vehicle to another.

The patent contains four claims, of which only Claim 3 is involved in this suit. That claim reads as follows:

"A license tag for a motor vehicle, comprising a frangible film, provided with identifying serial numerals, and adapted to be secured to a glass part of the motor vehicle against removal without destruction."



The accused device is the wheel tax license sticker issued by the City of St. Louis in 1940, which license tag is in the form of a commercial decalcomania bearing a serial number on the face thereof (R. 303, Finding of Fact No. 7). With reference to the identity of the accused device with the patented invention, the Court of Appeals said: "it is apparent that the city has substantially adopted Warden's plan for licensing automobiles" (R. 318).

The essential facts necessary for consideration in connection with the questions presented are succinctly stated in the opinion of the Court of Appeals. Briefly, they are as follows:

Warden made his invention in 1931. For ten years prior thereto, the City of Chicago had been issuing metal license discs as evidence of the payment of the annual city tax on automobiles, the said discs being about 5 inches in diameter and being bolted to a corner of the usual State license tag carried by the vehicle. These discs could be removed without difficulty, thus giving rise to a theft and fraud problem resulting in annoyance and expense to those whose discs were stolen and in loss of revenue to the City (R. 316).

The problem of the theft and unlawful transfer of these license discs in Chicago was a serious one. The officials whose duty it was to collect the tax on automobiles were aware of the problem and were trying to solve it but failed to arrive at a satisfactory solution (R. 316). Duplicate discs were required to be furnished at a small charge, and these comprised, on the average, as many as 4% of the number of original discs issued annually during the ten years from 1921 to 1931. Prosecutions by the City growing out of the stealing of such discs during that ten-year period were an every-day occurrence (R. 316).

In 1931, Warden, who had thrice been the victim of thieves who stole his license discs from his car, conceived

the idea of a license tag in the form of a decalcomania or sticker to be placed on the windshield, which could not be removed without destruction and which, therefore, would prevent the theft of the license tag (R. 317). He communicated his idea to the officials of Chicago and an ordinance was immediately passed putting his idea into effect (R. 317).

As the result of the adoption of Warden's license tag, the City of Chicago, during the first month of operation under Warden's system, collected an additional revenue of approximately \$250,000 over prior years. Since then, the number of duplicates issued has become negligible, as have also prosecutions for the theft of license tags (R. 317).

Suits for infringement against the City of Chicago and against Kansas City, Missouri, were terminated by consent decrees entered into by the suppliers of the infringing license tags (R. 317). Large manufacturers of decalcomanias have taken licenses under the patent in suit (R. 317). At the time of trial, about 150 villages and cities were licensed users of Warden's patented tag (R. 318).

The Court of Appeals, having first expressed the view that it was unnecessary "to analyze the prior art in detail" (R. 319), summarized its view of the case as follows:

"What Warden discovered was that a license tag or sticker consisting of a decalcomania or other frangible film attached to the windshield of an automobile was an economical and effective method of preventing the theft and unlawful transfer of automobile licenses. The discovery was a meritorious one, met with commercial success, and solved a long existing problem. The simplicity of the device which solved the problem should not militate against patentability if, in fact, invention was involved."

Because certain paper insurance certificates had previously been put on the windshields of taxicabs, the court answered the question of invention by saying:

“The conception that a frangible film license sticker would more adequately serve the purpose than a paper one, could not, we think, reasonably be regarded as the product of inventive genius” (R. 321).

Decalcomanias, as such, were concededly old before Warden made the invention in issue. Because patents on such decalcomanias had expired, the Court concluded that “the invention, for any and all purposes for which it is adapted, becomes public property and can be used by any one” (R. 320).

### **Questions Presented.**

1. When a court has found that a patentee has made a meritorious discovery which is an effective and economical solution of a long-existing and well-recognized problem, which others had failed to solve, and that his solution has commended itself to the public as evidenced by its prompt adoption and commercial success, may the court ignore these accepted indicia of invention and, disregarding the established law, conclude that the discovery resulted from the exercise of mere mechanical skill?

2. When a patentee has created out of an old material a new device in which a known characteristic of the old material is so utilized for the first time as to enable the device made therefrom to serve a new and useful purpose, is the patent invalid under the doctrine of *Roberts v. Ryer*, 91 U. S. 150, which is to the effect that the inventor of a machine (here, the material) is entitled to the benefit of all uses to which it can be put, whether he knew of them or not?

### **Reason Relied Upon For the Grant of a Writ of Certiorari.**

In urging the Court to grant the writ, petitioner desires to make it clear that he is not asking a retrial of the facts

but only a proper application of the law to the facts as found below.

The discretionary power of this Court is invoked upon the following grounds:

1. The Circuit Court of Appeals for the Eighth Circuit has decided important questions of Federal law in a manner which is believed to be untenable and in direct conflict with the applicable decisions of this Court.

2. The Circuit Court of Appeals for the Eighth Circuit has ~~decided~~ important questions of Federal law, the effect of which is of great public importance and concern because the patent in suit is of great and peculiarly direct public interest in that it has enabled the tax collectors of cities, towns and villages throughout the entire country more completely to perform their duties and thus more equitably to distribute the tax burden among the taxpayers.

WHEREFOR your petitioner respectfully prays that a writ of certiorari be issued out of and under the seal of this Court directed to the United States Circuit Court of Appeals for the Eighth Judicial Circuit, commanding said court to certify and send to this Court, on a day to be designated, a full transcript of the record and all proceedings of the Court of Appeals had in this case, to the end that this case may be reviewed and determined by this Court; that the judgment of the Court of Appeals for the Eighth Circuit be reversed, and that petitioner be granted such other and further relief as may to this Court seem proper.

HAROLD OLSEN,  
*Counsel for Petitioner.*

Dated: Chicago, Illinois, April 15, 1944.





## **BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.**

### **The Opinions of the Courts Below.**

The District Court did not file an Opinion. Its Findings of Fact and Conclusions of Law appear in the record at pages 303-306.

The Opinion of the Circuit Court of Appeals is now published in 140 F. (2) 615 (Advance Sheets for April 3, 1944) and is included in the record at pages 315-321.

### **Jurisdiction.**

The grounds of jurisdiction are:

1. The date of the judgment to be reviewed is February 14, 1944 (R. 321). Rehearing was denied March 7, 1944 (R. 337).

2. The statute under which the jurisdiction is invoked is § 240-A of the Judicial Code, 28 U. S. C. § 347, as amended by the Act of February 13, 1925.

3. Cases believed to sustain the jurisdiction are:

*The Williams Manufacturing Co. v. United Shoe Machinery Corporation*, 316 U. S. 364.

*The Goodyear Tire & Rubber Company et al v. Ray-O-Vac Company*, . . . U. S. . . . (No. 262—October Term 1943, decided February 28, 1944).

### **Statement of the Case.**

The facts are sufficiently stated in the petition.

### **Specification of Errors.**

The errors which petitioner will urge, if the writ of certiorari be granted, are that the Circuit Court of Appeals for the Eighth Circuit erred:

1. In failing to follow the principle of law firmly established by the decisions of this Court that, when a patentee has produced a new device which satisfies a long-existing, well-recognized want, which others had attempted in vain to supply, invention is to be inferred rather than the exercise of mechanical skill.

2. In holding that, because patents upon the material out of which petitioner's new device is made have expired, the public is free to make petitioner's new device.

3. In misapplying the decision of this Court in *Roberts v. Ryer*, 91 U. S. 150 to the facts of this case.

4. In holding that, because of the prior use of paper insurance certificates on the windshields of taxicabs the conception that a frangible film license sticker, for the purposes of the device of the patent in suit, cannot "reasonably be regarded as the product of inventive genius."

5. In failing to sustain the validity of the patent in suit upon the ground that it solved a long-existing, well-recognized problem in an effective and economical manner.

### **Summary of the Argument.**

The points of the argument follow the questions presented and are stated in the index hereto. For the sake of brevity they are omitted at this point.



## ARGUMENT

### Point I.

When a court has found that a patentee has made a meritorious discovery which is an effective and economical solution of a long-existing and well-recognized problem, which others had failed to solve, and that his solution has commended itself to the public as evidenced by its prompt adoption and commercial success, the court may not ignore these accepted indicia of invention and, disregarding the established law, conclude that the discovery resulted from the exercise of mere mechanical skill.

The District Court did not make any finding of fact that invention was not involved in the production of the patented device or that it was the result of the exercise of mere mechanical skill. Perhaps it was the view of the court that, because of the simplicity of the patent and of the prior art and the lack of necessity of extrinsic evidence, the question was one of law\* because it entered conclusions of law (R. 305) holding the patent invalid for lack of invention.

Apparently the Court of Appeals was of the same view because it found it "unnecessary to analyze the prior art in detail" (R. 319). That court's conclusion that the patented device could not "reasonably be regarded as the product of inventive genius," in view of the evidentiary facts found, must also be regarded as a conclusion of law.

Even if, in this case, the question of invention be regarded strictly as one of fact, this Court will, despite concurrent findings below, reverse if those findings are clearly erroneous. See *Altoona Publix Theatres v. American Tri-*

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\**Heald v. Rice*, 104 U. S. 737, 749; *Mahn v. Harwood*, 112 U. S. 354, 358; *U. S. v. Esnault-Pelterie*, 303 U. S. 26, 30.

*Ergon Corp.*, 294 U. S. 477, 488, in which this Court reversed the concurrent findings of the lower Courts on the question of invention in respect of claims 5 and 17 of the patent suit.

A finding is clearly erroneous if it is arrived at by the application of a wrong principle of law or by the failure to apply the correct principle of law. *Tilghman v. Proctor*, 125 U. S. 136; *Warren v. Keep*, 155 U. S. 265.

In the present case the conclusion of lack of invention is clearly erroneous because it was arrived at by the failure of the courts below to apply the correct principle of law to the evidentiary facts.

As set forth in the foregoing Petition, the Court of Appeals found that Warden had made a meritorious discovery which was an effective and economical solution of a long-existing, well-recognized problem, which others had tried in vain to solve, and that his solution was immediately adopted and has met with commercial success. These facts are the accepted indicia of invention and when they have been found to exist, the courts below should have concluded, under the controlling decisions of this Court, that invention was exercised and not mere mechanical skill.

This principle of law is most succinctly stated by this Court in *Paramount Publix Corp. v. American Tri-Ergon Corp.*, 294 U. S. 464, 474, as follows:

“Where the method or device satisfies an old and recognized want, invention is to be inferred, rather than the exercise of mechanical skill. For mere skill of the art would normally have been called into action by the generally known want.”

The Court then cites five earlier decisions to the same effect. And this principle was applied by the Court as

recently as February 28, 1944, when it decided the case of *The Goodyear Tire & Rubber Co. et al v. Ray-O-Vac Company*, . . . U. S. . . . (No. 262—October Term 1943).

The Court of Appeals found that the problem solved by Warden was a serious one and had existed for ten years (R. 316). It also found that "the officers whose duty it was to collect the tax on automobiles were aware of the problem and were trying to solve it, but had failed to arrive at a satisfactory solution" (R. 316). The record also shows the unsuccessful attempts of the patentee Jaschun of New York (patent No. 1,689,140, R. 76) and of Hulsebos of Michigan (patent No. 1,707,723, R. 80) to solve this well-recognized problem. Each proposed a readily removable metal license tag to be carried on the inside of the vehicle and which the driver would put in his pocket when he was not operating the automobile.

In these circumstances, the decision of this Court in *Expanded Metal Co. v. Bradford*, 214 U. S. 366, is directly applicable. The Court said (214 U. S. 381):

"It may be safely said that if those skilled in the mechanical arts are working in a given field, and have failed, after repeated efforts, to discover a certain new and useful improvement, that he who first makes the discovery has done more than make the obvious improvement which would suggest itself to a mechanic skilled in the art, and is entitled to protection as an inventor."

It is submitted, therefore, that the conclusion of the courts below that the patented device lacks invention is clearly erroneous and that the error arose by the failure of the courts to apply the correct principle of law as laid down in the controlling decisions of this Court.

## Point II.

When a patentee has created out of an old material a new device in which a known characteristic of the old material is so utilized for the first time as to enable the device made therefrom to serve a new and useful purpose, the patent may not be declared invalid under the doctrine of *Roberts v. Ryer*, 91 U. S. 150, which is to the effect that the inventor of a machine (here, the material) is entitled to the benefit of all uses to which it can be put, whether he knew of them or not.

The novelty of Warden's patented license tag for motor vehicles is not in the least affected by any of the prior art or practices of record. Prior to Warden's invention, there simply did not exist anywhere a license tag for a motor vehicle comprising a frangible film as described in Claim 3 of the patent in suit.

A decalcomania, as such, was old and well known prior to Warden's invention and this is conceded. Warden does not contend that he was the first to put a decalcomania upon an automobile, nor does he contend that he was the first to make a decalcomania having a number on it. But, clearly, these concessions have no bearing upon the question of whether it involved invention to create a license tag for motor vehicles in the form of a frangible film.

A decalcomania is a type of film which, because of the way it is made and the materials that are employed in it, inherently possesses the characteristic of frangibility. But no one before Warden ever thought of taking advantage of the frangibility of a film for the purpose of preventing the removal by theft and the unauthorized transfer of a motor vehicle license tag from one automobile to another.

The record shows that the material commonly known as a decalcomania is very old and that patents thereon issued

as early as 1863 (See patent No. 40,489 issued to Loewenberg Nov. 3, 1863, R. 51). All of the decalcomania patents of record in this case had expired many years before Warden made his invention. Because of this fact, the Court of Appeals mistakenly applied to the present case the doctrine of *Roberts v. Ryer*, 91 U. S. 150 which holds (91 U. S. 157):

“It is no new invention to use an old machine for a new purpose. The inventor of a machine is entitled to the benefit of all the uses to which it can be put, no matter whether he had conceived the idea of the use or not.”

The doctrine of the cited case is not applicable here because Warden has not simply discovered a new use for an old device. He has created an entirely new device for an entirely new purpose. The fact that the material out of which the new device is made may be old does not detract from the novelty of a new device made therefrom.

The case of *Roberts v. Ryer* was decided in 1875. Twenty years later this Court decided the case of *Potts v. Creager*, 155 U. S. 597. The latter case points out the distinction between a mere “double use” of an old device (that is to say, a merely different use) and a really *new* use in an entirely different art and for an entirely different purpose. This case clearly limits the doctrine of *Roberts v. Ryer*. In the course of the opinion, this Court said:

“Indeed, it often requires as acute a perception of of the relations between cause and effect, and as much of the peculiar intuitive genius which is a characteristic of great inventors, to grasp the idea that a device used in one art may be made available in another, as would be necessary to create the device *de novo*.” (155 U. S. 607-608.)

“As a result of the authorities upon this subject, it may be said that, if the new use be so nearly analogous to the former one, that the applicability of the device to its new use would occur to a person of ordinary me-

chanical skill, it is only a case of double use, but if the relations between them be remote, and especially if the use of the old device produce a new result, it *may* at least involve an exercise of the inventive faculty." (155 U. S. 608.)

The case of *Potts v. Creager* has been cited and followed in a host of cases in the lower courts under circumstances identical with those in the case at bar. Some of these cases are: *A. B. Dick Co. v. Wichelman*, 74 F. 799, (affirmed C. C. A. 2, 88 F. 264); *National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co.*, (C. C. A. 8) 106 F. 693; *Mallon v. Gregg*, (C. C. A. 8) 137 F. 68; *H. J. Heinz Co. v. Cohn*, (C. C. A. 9) 207 F. 547; *Rembusch v. Bennethum*, 214 F. 257; *Lakewood Engineering Co. v. Walker*, (C. C. A. 6) 23 F. (2) 623; *Silver-Brown Co. v. Sheridan* (C. C. A. 1) 71 F. (2) 935. This Court has also consistently adhered to the doctrine of *Potts v. Creager* and has cited it as recently as its decision in *The Goodyear Tire & Rubber Co. v. Ray-O-Vac*, ... U. S. ..., (decided February 28, 1944).

The outstanding fact is that during the entire ten-year period, when the problem of the theft and unauthorized transfer of license tags continued to vex the officials of the City of Chicago who tried unsuccessfully to solve it, decalcomanias were to be seen everywhere. Yet it did not occur to any one concerned with the problem that out of this old and well known material might be made a license tag which would completely solve the problem. Yet it is now contended that the solution "was always ready at hand and easy to be seen by a merely skilfull attention" (*Diamond Rubber Co. v. Consolidated Rubber Tire Co.*, 220 U. S. 428, 435). We submit that he who made this very useful discovery that others were incapable of seeing, and who has so greatly benefited the public, should not be deprived of the fruits of his invention on the mistaken conclusion that all he did was to discover a mere "double use" for an old device.

**Point III.**

The validity of the patent in suit is a matter of great public importance and concern because the patent is of great and peculiarly direct public interest in that it has enabled the tax collectors of cities, towns and villages throughout the country more completely to perform their duty and thus more equitably to distribute the tax burden among the taxpayers.

A reading of the specification of the patent in suit (R. 43 et seq.) shows that the whole purpose of the invention was to prevent the perpetration of frauds on the licensing officials of States and other Governmental bodies, and to save the public the annoyance and expense occasioned by the theft of their vehicle license plates. That the invention has accomplished its intended purpose is indicated by the statement of the Court of Appeals (R. 317) "Since the adoption by the City of Chicago of Warden's plan of licensing automobiles, the number of duplicates issued has become negligible, as have also prosecutions for the theft of licensed tags."

In this respect the patent in suit touches more directly the public interest than perhaps any other patent that has been before this Court in many years. Over 150 cities and villages are licensed users of the patented invention. There are also unlicensed users, such as the City of St. Louis, defendant in this case.

We submit, therefore, that the question of the validity of the patent in suit is an important one to a great many Governmental units throughout the country and is of great interest to the taxpaying public.

### CONCLUSION.

In these times when the lower courts are beset with grave doubts and confusion because of a feeling that there is a pronounced new "doctrinal trend" by this Court in its decisions in patent cases (see, for example, *Picard v. United Aircraft Corp.* (C. C. A. 2), 128 F. (2) 532; *Chicago Steel Foundry Co. v. Burnside Steel Foundry Co.* (C. C. A. 7), 132 F. (2) 812; *Trabon Engineering Corp. v. Dirkes* (C. C. A. 6), 136 F. (2) 24; *Abbott Machine Co. v. Universal Winding Co.* (C. C. A. 1), 137 F. (2) 166), and when the National Patent Planning Commission has found that the lack of a uniform standard or test for determining patentability is the most serious weakness in the patent system, threatening its usefulness, and recommends the declaration of a national policy that patentability shall be determined objectively (see the report of the Commission printed as House Document No. 239, 78th Congress, 1st Session, *V. Uniform Standard of Invention, A. Declaration of National Policy*), we submit that the present case is an appropriate one for the exercise by this Court of its supervisory power to take up the case and to reaffirm the settled principle that invention is not to be denied where a long-existing, well-recognized problem has been effectively and economically solved.

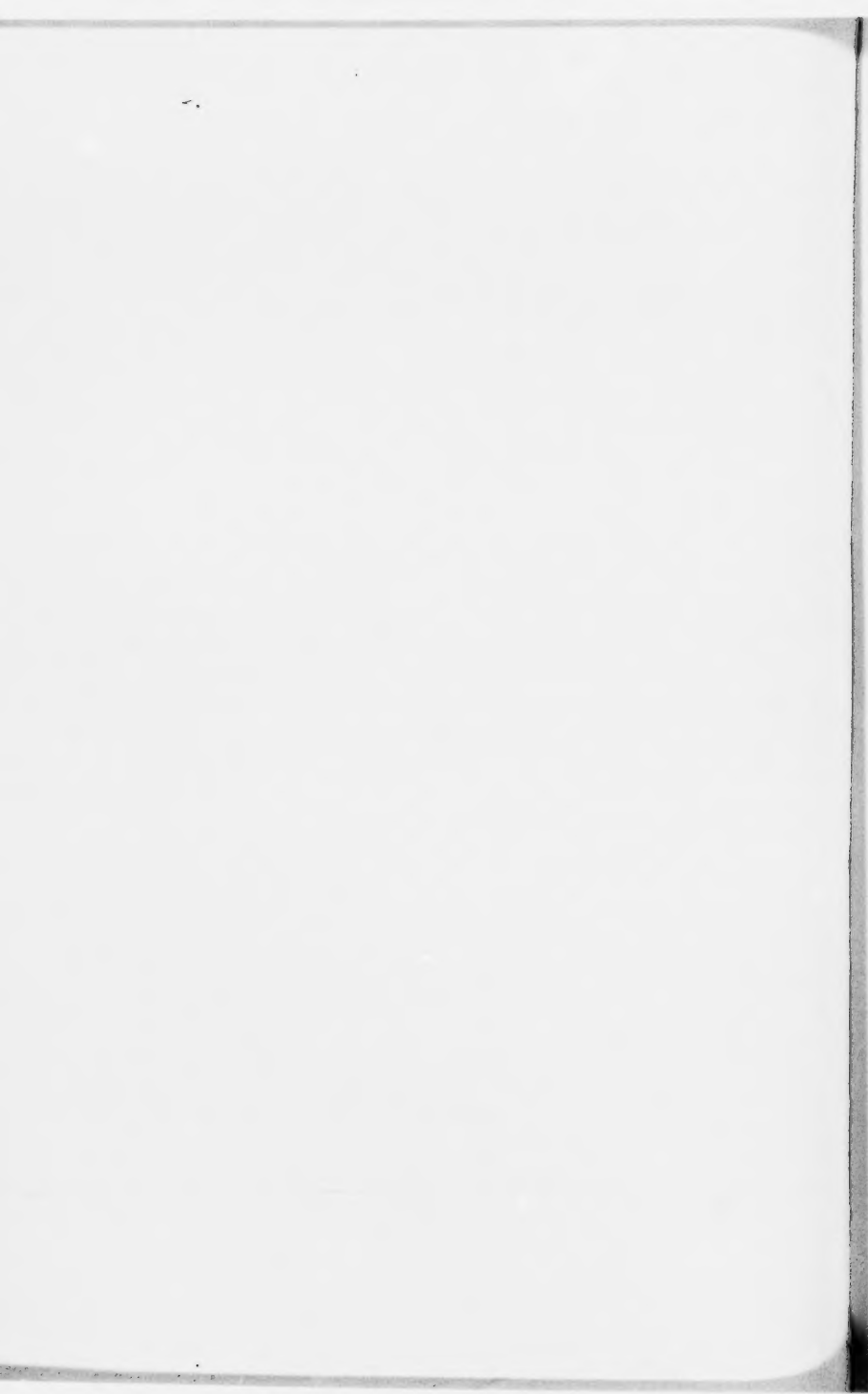
It is prayed, therefore, that a writ of certiorari be granted and that this Court review the decision of the Circuit Court of Appeals for the Eighth Circuit and reverse it.

Respectfully submitted,

HAROLD OLSEN,  
*Counsel for Petitioner.*







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CHARLES ELMORE CROPLEY  
CLERK

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Respondent.

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**BRIEF IN OPPOSITION TO WRIT  
OF CERTIORARI.**

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IN THE  
**SUPREME COURT OF THE UNITED STATES.**

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OCTOBER TERM, 1943.

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No. 897.

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HENRY I. WARDEN,  
Petitioner,

v.

CITY OF ST. LOUIS, MISSOURI,  
Respondent.

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**BRIEF IN OPPOSITION TO WRIT  
OF CERTIORARI.**

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**Statement.**

The basis of this whole suit is petitioner's claim that a conventional automobile windshield sticker license, comprising a piece of every-day decalcomania with the usual and necessary serial numbers thereon, is invention.

It is no more than that—a few regular symbols on an ordinary decalcomania, for sticking to a windshield. Claim 3 of petitioner's patent, read forward or backward, has no more in it than that.

The City of St. Louis has already had to defend itself in two courts against this absurd claim. Both courts, of course, held the patent invalid. Now petitioner apparently expects this court to reverse both lower courts.

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Decalcomanias with serial numbers are admittedly old in the art. (See Howard patents, R. 59, 63, 67, 71.) These are identical in every respect with petitioner's article. They were described as used for meat inspection tags, instead of automobile license tags. In other words, the difference is only one of *use*.

Windshield license stickers made of paper, with the usual serial numbers, were used several years before petitioner's claimed invention (R. 286, 293). These are identical with his patent claim, except for the matter of using decalcomania instead of paper.

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Petitioner himself admitted that the use of decalcomania stickers, without serial numbers, on automobiles, was old (R. 13, 16, Int. 6). In fact, he probably had an automobile club decalcomania on his car at the time of his claimed invention (R. 37).

Not only that, but petitioner admitted that decalcomania stickers, *with* serial numbers, were used on glass other than automobile windshields (R. 13, 16, Int. 6). Thus his maximum claim to invention lay in using the old device on automobile glass instead of shop door glass.

### **The Issues.**

Therefore, the whole issue, decided uniformly by the courts below, resolves itself into whether it was invention either

(a) to employ a decalcomania with serial numbers, concededly old, on an automobile glass instead of on some other object, or

(b) to substitute decalcomania, concededly old, as the material for paper in windshield license stickers with serial numbers, the paper stickers being concededly old.



## The Legal Precedents.

It is an unquestioned and venerable rule of law that a different use of the same old article is not invention. Thus, employing the meat sticker as an automobile sticker, is not invention.

*Roberts v. Ryer*, 91 U. S. 150;

*Ansonia Brass & Copper Co. v. Electrical Supply Co.*, 144 U. S. 11;

*Phillips v. Page*, 65 U. S. 164.

It is an unquestioned and venerable rule of law that substituting one known material for another, merely to obtain the obvious and familiar properties of the substituted material, is not invention.

*Hotchkiss v. Greenwood*, 11 How. 247.\*

It is further a prerequisite of patentability that something more than ordinary intelligence be demonstrated. Making a license sticker out of a few symbols printed into a decalcomania was not, and never could have been, invention.

*Cuno Engineering Corp. v. Automatic Devices Corp.*,  
314 U. S. 84.

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\*It is interesting to observe that both of these rules are set out in a single statement of Thomas Jefferson, in a letter reviewing his own experience on the patent board when he was Secretary of State. He said (Jefferson's Works, Vol. XIII, p. 326):

"Some (rules), however, were established by that board. One of these was, that a machine of which we are possessed, might be applied by every man to any use of which it is susceptible, and that this right ought not to be taken from him and given to a monopolist, because the first perhaps had occasion so to apply it. Thus a screw for crushing plaster might be employed for crushing corncocks. And a chain pump for raising water might be used for raising wheat; this being merely a change of application. Another rule was that a change of material should not give title to a patent. As the making a ploughshare of cast rather than of wrought iron; a comb of iron instead of horn or ivory, or the connecting buckets by a band of leather rather than of hemp or iron. A third was that a mere change of form should give no right to a patent, as a high-quartered shoe instead of a low one; a round hat instead of a three-square; or a square bucket instead of a round one. But for this rule all the changes of fashion in dress would have been under the tax of patentees."

Both courts below held petitioner's patent invalid for the foregoing reasons. The result was unmistakably proper and conventional, and presents no trace of reason for review by another court. The patent is dead and may well be left alone.

*Goodyear T. & R. Co. v. Ray-O-Vac Co.*, ... U. S. ... , 88 L. ed. 475.

### **Petitioner's Arguments.**

Petitioner offers three alleged points that are wholly fallacious.

Point I urges that a court may not hold invalid a patent that has enjoyed commercial success. This is not true. Commercial success is never a substitute for invention. The Court of Appeals held that there was not invention in the patent, *despite* the commercial success. The District Court (we think rightly) further held that there was no true commercial success, measured against the proper standards.

Neither view changes by one iota the recognized law. Lack of invention being plain, commercial success is of no consequence.

*Textile Machine Works v. Louis Hirsch T. M.*, 302 U. S. 490;

*Toledo Pressed Steel Co. v. Standard Parts*, 307 U. S. 350.

Point II avers that the Court of Appeals should not have declared the patent invalid, because *Roberts v. Ryer*, 91 U. S. 150, does not apply. A threshold answer to this is that the ultimate result reached was correct, and this Court should not be asked to advise the Court of Appeals to cite a different prior decision.

On the merits, moreover, petitioner is wrong. The facts are (and they are *facts* agreed upon by both lower courts)

that petitioner did not create a new device, but only employed an old one for a new use. *Roberts v. Ryer* is applicable authority for the *factual* conclusion reached below.

Point III avers that the validity of the patent is of great public importance. To the contrary, its *invalidity* is of great public importance, and that result has been properly reached by the courts below.

### **Conclusion.**

Respondent argued below that under no interpretation of the requisites of invention, old or new, could this device be considered invention. There is no new point here involved. The case represents only a conventional application of familiar doctrines that have lived without change through decades of patent adjudication.

The imprinting of a few obvious symbols onto decalcomania, for sticking onto a windshield, is not invention.

Respectfully submitted,

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